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OFFICE OF PETITIONS

In re Application of :
Makoto Shonohara : DECISION ON PETITION
Application No. 10/825,334 :
Filed: April 16, 2004 :
Attorney Docket No. D-1588 :

This is a decision on the petition under 37 CFR 1.137(a), filed February 8, 2006, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time under 37 CFR 1.136(a) are permitted.

The above-identified application became abandoned for failure to file a timely response to the nonfinal Office Action, mailed June 30, 2005, which set a three-month shortened statutory period for reply. The above-identified application became abandoned on October 1, 2005. The present petition preceded the mailing of a Notice of Abandonment.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant

> application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
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> (2) The petition fee as set forth in 37 CFR 1.17(l);
>
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The Director may require additional information where there is a question whether the delay was unintentional; and
>
> (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable.[1]"

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[2]

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[1] 35 USC § 133.

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[3]

With regard to requirement (3):

In the present petition, applicant's legal representative asserted that he never received the nonfinal Office Action of June 30, 2005, because the USPTO mailed it to his previous office with an old correspondence address. The practitioner stated that the present application was filed on April 16, 2004, and indicated the correspondence address as Kanesaka and Takeuchi, 1423 Powhatan Street, Alexandria, VA 22314. The practitioner explained that on May of 2004, he established the Office of Hauptman Kanesaka Berner Patent Agents LLP at 1700 Diagonal Road, Alexandria, VA 22314. His former partner, Yusuke Takeuchi, established the Office of Takeuchi and Takeuchi at 1700 Diagonal Road, Alexandria, VA 22314. The practitioner stated that after he moved, he asked the Office manager to change the address in all of the files he was acting as a principle agent. The Office manager asserted that he contacted the Electronic Business Center of the USPTO and obtained an electronic list of the applications that the practitioner was listed on the declaration at the time of filing the applications.

The practitioner stated that addresses of the files were changed according to the list provided by the USPTO. The practitioner averred that the present application was not included in the electronic list, even though his name was present on the declaration. The practitioner stated that the Office Action of June 30, 2005, was not delivered to him, and the application became abandoned. The practitioner asserted that the address of the present application was not changed inadvertently with the USPTO

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[2] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[3] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887.

because the list obtained from the USPTO did not contain the application. Therefore, applicant contended that the abandonment of this application was unavoidable, and requested that the USPTO remail the Office Action and restart the period for reply.

A review of the written record indicates that the nonfinal Office Action was properly mailed to Kanesaka and Takeuchi, 1423 Powhatan Street, Alexandria, VA 22314, which was the address of record as it existed on June 30, 2005. The Office Action was returned to the USPTO with an indication from the USPS that the forwarding time had expired and to return to sender. Therefore, applicant did not receive the nonfinal Office Action because he failed to file a timely change of correspondence address with the USPTO. Applicant did not file a change of correspondence address with the USPTO until February 9, 2006, over seven months after the mailing of the Office Action, and 21 months after the practitioner moved his Office. Nonetheless, applicant argued that the practitioner did not receive the nonfinal Office Action because the USPTO failed to identify this application in the electronic list, which was supplied to the Office manager.

Initially, the Office notes that the belated notification to the USPTO of the change of correspondence address does not constitute proper notification as to establish unavoidable delay. An applicant is responsible for promptly notifying the USPTO of any change of correspondence address. The Office further notes that where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of "unavoidable" delay requires a showing that applicant exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application.[4] Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.[5]

Although the Electronic Business Center attempted to provide the practitioner with a list of applications in which he appeared on the declarations at the time of filing, the USPTO has no obligation to track and notify the practitioner of all of the applicants he represents. Rather, it is the practitioner who is ultimately

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[4] MPEP 711.03(c)(III)(C)(2).

[5] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987); Vincent v, Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

responsible for tracking and maintaining all of the applications in which he is empowered and to ensure that a timely change of correspondence address is submitted to the USPTO for each application. It is unfortunate if the list did not identify the present application; however, this does not relieve the practitioner and applicant from their duty to submit a timely change of correspondence with the USPTO.

The USPTO must rely on the action or inaction of a duly authorized and voluntarily chosen representative of the applicant, and the applicant is bound by the consequences of those actions or inactions.[6] Specifically, an applicant's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay with in the meaning of 35 USC § 133.[7]

As applicant did not provide a sufficient showing that the delay was unavoidable within the meaning of 35 USC § 151 and 37 CFR 1.137(a), the petition is **dismissed**.

Alternative Venue:

Instead of filing a renewed petition under 37 CFR 1.137(a), petitioner may wish to file a petition pursuant to 37 CFR 1.137(b) on the basis of **unintentional** delay.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

> (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In

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[6] Link v. Wabash, 370 U.S. 626, 633-634 (1962).

[7] Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-1132 (N.D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(m), an additional $1,500.00 for a large entity and $750.00 for a small entity;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and,

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The Office finance records indicate that applicant paid a $130.00 fee for filing the petition under 37 CFR 1.137(a). The petition fee increased to $500.00. Therefore, the Office charged the Deposit Account for the difference owed in the amount of $370.00, as authorized.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
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Office of Petitions